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PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
TECHNOLOGY CENTER ART UNIT 2142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masaru TAKEDA et al.

Group Art Unit: 2142

Application No.: 09/716,415

Examiner: H. Nguyen

Filed: November 21, 2000

Docket No.: 107904

For: INFORMATION OUTPUT SYSTEM UTILIZING ELECTRONIC MAIL

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

**DEC 09 2004**

Technology Center 2100

Sir:

In reply to the September 7, 2004 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-21 are pending herein.

**I. Rejections Under 35 U.S.C. §103(a)**

Claims 1-3, and apparently also claims 17 and 19-21, were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,587,219 (hereinafter "Saito") in view of U.S. Patent No. 6,470,332 (hereinafter "Weschler").

Claims 4-11, and apparently also claims 17 and 18, were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler and further in view of U.S. Patent No. 6,223,226 (hereinafter "Miyahara").

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler, further in view of Miyahara, and still further in view of an allegedly known feature of conversion of a PDL file.

Claim 14, and apparently also claims 15 and 16, were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Saito in view of Weschler, in view of Miyahara, in view of an allegedly known feature of conversion of a PDL file, and further in view of the allegedly known feature of checking for a virus in electronic mail.

These rejections are respectfully traversed.

**A. Searching via a Search Section**

Saito is directed towards an internet facsimile apparatus. As acknowledged by the Patent Office, Saito fails to teach or suggest searching a group for one candidate or a plurality of candidates in response to a search request, as recited in claims 1, 5, 17, 19, 20 and 21.

Specifically, the Patent Office states that Saito does not disclose searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus. The Examiner cites Weschler as allegedly curing the deficiency of Saito.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, even if the references could somehow have been combined, the Examiner has provided no motivation or suggestion as to why one would have combined the references. For

example, in the Response to Arguments, the Examiner never indicates where the references themselves provide any motivation for combining the teachings. The Patent Office thus has failed to establish a proper *prima facie* case of obviousness. While, Applicants argued that there is no motivation to combine Saito and Weschler in their communication filed May 24, 2004, the Patent Office has so far failed to respond to the arguments.

Moreover, Saito in fact would have led one away from combining the references in the manner asserted by the Patent Office. Saito discloses an invention where the operator can transmit image information via a relay apparatus only by inputting a facsimile number of the final destination. See column 3, lines 31-35 and column 5, lines 16-24 of Saito. Because Saito works through input of information already known by the user, there is no need for the conducting of any searching. That is, there is no need or utility in Saito for searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus.

Thus, in the Saito system, there is no need for searching an output apparatus group for one candidate output apparatus or a plurality of candidate output apparatuses in response to a search request from a terminal apparatus because a facsimile number of the final destination is required.

According to the Patent Office, Weschler teaches finding the resources in the distributed system by use of directories. The directories are data structures that hold information such as mail address book information, printer locations, public infrastructure information, and the like. However, there is no need for searching in Saito as discussed extensively above. Therefore, one of ordinary skill in the art would not have combined Saito and Weschler as alleged by the Patent Office. That is, one would not have sought to include any searching function in the Saito system because it would have no utility therein, Saito requiring input of known information.

Further, Weschler does not teach or suggest searching a group for an output resource, such as a printer, or a plurality of output resources. Weschler only discloses searching for directory attributes that do not interact with each other. See column 4, lines 33-35 of Weschler. Therefore, even if Saito and Weschler were to have been combined, the present invention as recited in claims 1, 5, 17, 19, 20 and 21 would not have resulted. The Patent Office alleges that Weschler discloses searching directories in a computer system. However, the directories of Weschler do not suggest a terminal apparatus searching for an output apparatus or a plurality of output apparatuses as recited in present claims 1, 5, 17, 19, 20 and 21.

**B. Managing, Notifying and Distinguishing Sections**

Moreover, Saito does not teach or suggest a system with a managing section for managing a mail address for each output apparatus as recited in claims 1, 5, 17, 19, 20 and 21. The managing section serves to manage a mail address for each output apparatus. However, in Saito, it is not a mail address for each output apparatus (each facsimile apparatus) that is managed, but a mail address of each relay apparatus. A facsimile number of each output apparatus is information already known to the user and not information to be searched and then notified to the user. See column 3, line 66 through column 4, line 7 of Saito.

Further, Saito does not teach or suggest a notifying section that notifies the mail address of the candidate output apparatus as recited in claims 1, 5, 17, 19, 20 and 21. Instead, Saito teaches that the mail address of the relay apparatus, not the candidate output apparatus, is notified. See column 5, lines 15-19 of Saito.

Finally, Saito does not teach or suggest a distinguishing section that distinguishes a designated output apparatus based on a destination mail address as recited in claims 1, 5, 17, 19, 20 and 21. Instead, Saito specifies a designated output apparatus based on a facsimile number.

Weschler does not remedy any of these additional deficiencies of Saito. In particular, Weschler also does not teach or suggest a managing section, notifying section or distinguishing section as recited in claims 1, 5, 17, 19, 20 and 21.

**C. Miyahara and Allegedly Known Features**

Further, none of Miyahara, the feature of conversion of a PDL file or the feature of checking for a virus in electronic mail remedy the deficiencies of, or provide any motivation to combine Saito and Weschler. Namely, none of Miyahara or the known features teach or suggest searching an output group/printer for one candidate or a plurality of candidates in response to a search request from a terminal apparatus, as required by claims 1, 5, 17, 19, 20 and 21. Furthermore, none of Miyahara or the known features teach or suggest a managing section, notifying section or distinguishing section as recited in claims 1, 5, 17, 19, 20 and 21.

**D. Conclusion**

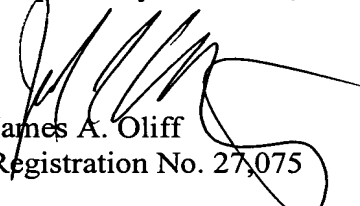
Thus, for all the foregoing reasons, reconsideration and withdrawal of the rejections are respectfully requested.

**II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: December 7, 2004

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